

C. REMARKS

Status of the Claims

Claims 1, 3, 6-9, 12-14, 16-20, 23-25, 27-31, 34-39, 41-44, 46-49, and 54-56 are pending in the application. Claims 1, 5-7, 25, 27-29, 36, 41, 46, and 54-56 are currently amended.

Lack of Obviousness under Chang, Tang, and Wong separately or in combination in Claims 1, 3, 6-9, 12-14, 16-20, 23-25, 27-31, 34-39, 41-44, 46-49, and 54-56

The Office Action rejects claims 1-5, 8-16, 19-27, and 30-56 under 35 U.S.C. §103(a) as being allegedly unpatentable over Chang et al. (US Patent 6,105,012) (hereinafter referred to as Chang) in view of Tang et al. (US Patent 6,532,477) (hereinafter referred to as Tang) and further in view of Wong et al. (US Patent 6,978,293) (hereinafter referred to as Wong). [Office Action, p. 2] Applicants note that claims 2, 4, 10, 11, 15, 21, 22, 26, 32, 33, 40, 45, and 50-53 were previously cancelled. Thus, the rejection as to claims 1, 3, 6-9, 12-14, 16-20, 23-25, 27-31, 34-39, 41-44, 46-49, and 54-56 is respectfully traversed.

Claims 1, 14, and 25

Independent method claim 1, which is representative of system claim 14 and computer program product claim 25 with regard to similarly recited rejection, reads as follows:

1. (Currently Amended) A method, in at least one server system for enabling at least one real time chat messaging session channel via a network between at least a selection of a plurality of separate client systems communicatively connected to said network, for recording a real time chat messaging session, said method comprising the steps of:

applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated within said chat messaging session between said selection of said plurality of separate client systems, wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems; and

recording, at said at least one server system, a log of said chat messaging session, wherein said log comprises said plurality of messaging entries with each said separate distinguishable watermark applied, such that an origin of each of said plurality of message entries stored in said log is traceable and the integrity of

each of said plurality of message entries stored in said log is verifiable according to said distinguishable watermark.

In the rejection of claims 1 and 25 the Examiner states the following ground of rejection:

Chang teaches the invention substantially as claimed including a method and apparatus for securely transmitting transactions from an application program (see abstract).

Regarding claims 1 and 25, Chang teaches a method, in at least one server system for enabling at least one messaging session via a network between at least a selection of a plurality of separate client systems communicatively connected to said network, and program for recording a messaging session, said method comprising the steps of:

applying a separate distinguishable digital watermark to each of a plurality of message entries communicated within a messaging session, wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems (fig. 1, fig 2., col. 4, lines 21 – 31, Chang discloses messages given a digital signature); and

recording a log of said messaging sessions, wherein said log comprises said plurality of messaging entries with each said separate distinguishable watermark applied, such that an origin of each of said plurality of message entries stored in said log is traceable and the integrity of each of said plurality of message entries stored in said log is verifiable according to said distinguishable watermark (col. 5, lines 55-67, Chang discloses an audit trail that keeps track of users and their digital signatures on messages and the digital signature signifying a particular user which identifies the origin of message, col. 2, line 62 – col. 3, line 4, Chang discloses the storage of users public key to verify a digital signature).

Chang fails to teach the limitation further including the use of a digital watermark on messages in a chat messaging system and a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Tang teaches a method and an apparatus for generating an audio signature for a data item based on a source identifier associated with the data item (see abstract). Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract; col. 1, line 59 – col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signature can convey where and whom the message originated from. [Office Action, pp. 3-4]

Chang and Tang fail to teach the limitation further including a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches systems and methods for selecting criteria for a successful acknowledgment message criteria in instant messaging (see abstract). Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51). [Office Action, pp. 2-4]

Similarly, the Examiner cites the same grounds of rejection for claim 14 as are stated for claims 1 and 25. [Office Action, pp. 7-8] Applicants note that claims 1 and 25 are amended to clarify that the messaging server facilitating chat messaging sessions applies and records, which is already clearly taught in claim 14. Applicants traverse the rejection of claims 1, 14, and 25.

The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a *prima facie* case of obviousness as to 1, 14, and 25 for the following reasons.

There is no suggestion or motivation to modify Chang by Tang and Wong

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Chang by Tang and Wong must come from the teachings of the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “indsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.

Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

use of digital watermark on messages in a chat messaging system

The Examiner states that Chang discloses the elements of claims 1, 14, and 25 except “the limitation further including the use of a digital watermark on messages in a chat messaging system.” [Office Action, p. 3] The Examiner cites Tang as teaching “a method and apparatus for generating an audio signature for a data item based on a source identifier associated with the data item” in the abstract of Tang. [Office Action, p. 3] In addition, the Examiner cites Tang as teaching “the use of an audio signature attached to a data item in an instant messaging system.” [Office Action, p. 4] The Examiner concludes “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the messages originated from. [Office Action, p. 4]

Applicants respectfully assert that there is no suggestion or motivation for the modification of Chang by Tang to teach applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated within a chat messaging session, wherein each separate distinguishable digital watermark identifies a separate origin of said message entries from among said plurality of separate client systems. In particular, Applicants respectfully assert that regardless of whether Tang actually teaches “use of a digital watermark on messages in a chat messaging session,” there is no motivation or suggestion for modifying Chang’s financial transaction system to teach communication via a chat messaging session or to teach use of a digital watermark on messages in a chat messaging system. In addition, Applicants respectfully note that the Examiner’s assertion that one would be motivated to modify Chang in view of Tang et al to use a digital watermark on messaging in a messaging system “because the signatures can convey where and whom the message originated from” does not address the primary issue of the lack of motivation or suggestion for modifying Chang to teach or suggest “a chat messaging session”.

Chang describes a financial server with “a repository of web pages associated with various financial services provided by a financial server. The web pages contain HTML documents and forms representing financial transactions that are exchanged between the user and the server.” *Chang*, col. 2, lines 1-5. In addition, Chang describes that encrypted HTML documents and encrypted HTML forms are downloaded to the user’s web browser from a financial server over a network and transferred from the user’s web browser to the financial server. *Chang*, col. 3, lines 66-20. Thus, Chang is a system that enables automated downloading of HTML pages and forms for user viewing and interaction within a web browser. In contrast, a chat messaging session enables a communication channel for real time conversation via computer between the two or more users at client systems. There is no motivation or suggestion, in Chang, Tang, or in the knowledge of one with skill in the art for modifying Chang’s automated communication session between a web browser and the financial server for enabling secure transfer of HTML documents and forms, to instead teach an instantaneous communication session between the user and the financial server. As there is no suggestion or motivation for such a modification, Applicants respectfully assert that a *prima facie* case of obviousness is not established and claims 1, 14, and 25 should be allowed.

a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session

The Examiner states that Chang and Tang fail to teach the limitation of a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. [Office Action, p. 4] The Examiner cites Wong as describing “systems and methods for selecting criteria for a successful acknowledgement message criteria in instant messaging (see abstract). Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).” [Office Action, p. 4] The Examiner concludes that “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and

Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51).” [Office Action, p. 4]

Applicants respectfully assert that there is no motivation or suggestion to modify Chang by Tang and Wong to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

Applicants respectfully assert that the Examiner’s proposed modification of Chang by Tang and Wong to teach a messaging server for enabling a real time chat messaging session channel via the network between multiple client systems would first require a motivation or suggestion for modifying Chang’s financial server to enable communication between the client systems communicatively connected to the financial server and then would require a motivation or suggestion for modifying Chang’s modified system to teach Wong’s messaging system. There is no suggestion or motivation for both of these modifications.

First, Applicants respectfully assert there is no motivation for suggestion for modifying Chang et al’s financial server system to facilitate communications between the client systems communicatively connected to the financial server system. Chang describes a financial transaction system with a communication mechanism that ensures that financial transactions are securely transmitted between the user at a client system and the server across a public network. *Chang*, col. 1, lines 56-61. The financial server system does not facilitate communications between client systems, and in fact, teaches away from such a modification by specifically teaching a financial system that secures the transactions between each client system and the server system so that no other system is able to read transacted data. *Chang*, col. 1, lines 56 through col. 2, line 9. Thus, regardless of whether there is motivation for modifying Chang to enable faster communication between a client system and the server system, there is not any suggestion or motivation for modifying the financial transaction system of Chang, which

specifically secures communications between a client system and the financial system, to instead facilitate communication between multiple client systems. Therefore, there is also no suggestion or motivation for modifying Chang to teach a financial server that facilitates real-time communication between multiple client systems in a chat messaging session, and in fact, Chang teaches away from such a modification.

Second, Applicants respectfully assert that even if there were suggestion or motivation for modifying Chang by Tang, there is still not motivation or suggestion for modifying Chang by Tang and Wong. Even if there was motivation or suggestion for modifying Chang's secured transaction session between a financial server and a web browser at a client system to implement a chat messaging session between the financial server and a user at the web browser, as the Examiner asserts in the modification of Chang by Tang, there is still no suggestion or motivation for modifying the financial server of Chang to teach facilitating a chat messaging session between multiple client systems communicatively connected to the financial server. In particular, as previously stated, there is no motivation or suggestion for modifying Chang's financial server system, specifically designed to secure a transaction between a client system and the financial server from access by any other system, to instead teach a system for facilitating chat communications, even if secured, between the client systems communicatively connected to the financial server via the network.

Therefore, because there is no motivation or suggestion for modifying Chang or Chang in view of Tang to teach a server system for facilitating any kind of communication channel between multiple client systems, there is no suggestion or motivation for modifying Chang or Chang in view of Tang by Wong to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Because there is no suggestion or motivation for modifying Chang and Tang by Wong to teach each and every element of claims 1, 14, and 25, a *prima facie* case of obviousness is not established and the claims should be allowed.

Chang, Tang and Wong do not teach or suggest all of the claim limitations of claims 1 and 25

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, each of the elements of claims 1, 14, and 25.

Neither Chang, Tang, nor Wong, separately or in combination, teaches or suggests applying, at said at least one server system, a separate distinguishable digital watermark to each of a plurality of message entries communicated within said chat messaging session, wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems because the combination of Chang, Tang, and Wong does not teach a server system for facilitating a chat messaging session applying a separate distinguishable watermark to each of a plurality of message entries to identify the client system sending each message entry.

First, Applicants respectfully assert that Chang does not teach or suggest a server system that facilitates a messaging session applying a separate distinguishable digital watermark to each message entry in the messaging session to identify a separate client system from which the message entry originated. The Examiner cites figures 1 and 2 and col. 4, lines 21-31 of Chang as disclosing applying a separate distinguishable watermark to each of a plurality of message entries because Chang discloses “messages given a digital signature.” [Office Action, p. 3] The abstract of Chang describes:

“[a] financial transaction processing system includ[ing] at least one financial server connected through a public network to a number of users associated with client computers. Each user accesses the financial server through a web browser. The web browser is provided with the capabilities to generate encryption keys, to

encrypt and decrypt HTML forms, and to digitally sign and timestamp HTML forms. The financial server transfers web pages including HTML forms representing financial transactions. [...] An HTML form can be transmitted in an encrypted format, in a format including a user's digital signature and timestamp, and in an encrypted format that contains the user's digital signature and timestamp. The financial server tracks each processed transaction through an audit trail including the user's account, the user's digital signature, the timestamp of the transaction, and the text of the transaction."

Chang, col. 4, lines 21-31 describe:

"web browser 216 is equipped with encryption procedures 220, timestamp procedures 228, digital signature procedures 230, and random key generation procedures 232. The random key generation procedures 232 are used to generate session keys that are used in conjunction with the encryption procedures 220 to encrypt a return message. The digital signature 230 and timestamp 228 procedures enable the web browser to digitally sign and timestamp a return message 143. In addition, the initialization procedures 226 enable the web browser 216 to generate encryption keys 218 that are used to represent and verify a user's digital signature."

Thus, Chang describes a web browser, at a client system, equipped to encrypt financial transaction data to be sent from the client system to the financial server using digital signature encryption keys. The Examiner equates Chang's web browser, at a client system, which encrypts financial transaction data using a digital signature to the claimed server system for facilitating a message session applying a digital watermark to each message to identify the client system from which the message originated. Chang does not, however, teach the financial server applying a digital signature to a transaction where the digital signature identifies the client system from which the transaction originated. Further, because Chang describes a system in which each system secures a transaction before sending the transaction to another system, there is no suggestion in Chang for modifying one system receiving a message from another system to apply a digital signature to the message that identifies the system from which the message is received.

Second, Applicants respectfully assert that Tang does not teach or suggest a server system that facilitates applying a separate distinguishable digital watermark to each message entry in the messaging session to identify a separate client system from which the message entry

originated. Tang et al, when considered as a whole, describes a system which (1) receives a communication of a data item, (2) generates a sound based on a source identifier (such as an email address) associated with the data item, and (3) controls output of the generated sound at the receiving system to identify, at that particular receiving system, the source of the new communication. *Tang, et al.*, col. 1, line 58-col. 2, line 19, col. 3, lines 34-57. Tang describes that a communication may include a communication in an instant messaging system. *Tang, et al.*, col. 2, lines 12-19. Tang's description of controlling output of a particular sound to "enable the user to associate the audio signature with the source from which the data item originated" does not, however, teach "an audio signature attached to a data item in an instant messaging system", as asserted by the Examiner. In addition, Tang's description of generating and outputting the audio signature does not teach or suggest applying an audio signature to an instant messaging communication. In fact, Tang et al's generated audio signature is created at the receiving system, based on preferences set at the receiving system, and therefore only audibly identifies a "source identifier" of a communication as generated by that particular receiving client system for a particular receiving user. Therefore, regardless of Tang's description of associating a sound with an email address of a communication, Tang's system merely provides a method for audibly alerting a recipient to a message; generating an audio alert based on an email address does not teach or suggest a system that applies a marking to a message entry identifying the source of the message entry.

Third, Applicants respectfully assert that Chang in view of Tang does not teach or suggest a server system that facilitates applying a separate distinguishable digital watermark to each message entry in the messaging session to identify a separate client system from which the message originated. In particular, there is no teaching in either of Chang, Tang or the combination of the references of a first system receiving a message from a second system and the first system applying a marking on the message to identify the second system from which the message was received. Chang describes a client system at which digital signatures are applied to a message before the message is sent to the server. Tang describes a client system that receives a message and audibly alerts the user to the message based on an audio signature generated for the email address or other identifier on the message. The combination of the references does not

teach or suggest a server system which receives one or more messages and applies a separate, distinguishable watermark to each message to identify the client system from which each message originated.

Finally, Applicants respectfully assert that Chang et al and Tong et al further in view of Wong does not teach or suggest a server system that facilitates applying a separate distinguishable digital watermark to each message entry in the messaging session to identify a separate client system from which the message originated. Wong describes, an instant messaging system in which a server system facilitating messaging sessions receives an instant message, determines whether user specified criteria for successful delivery of the message have been met, and if the criteria have been met, the computer system returns an acknowledgement message to the user sending the message. *Wong*, abstract, col. 2, lines 27-41. Wong does not describe a server system that actually adjusts a message in any way and, in particular, Wong does not describe a server system that applies markings to distributed messages. Furthermore, Applicants respectfully assert that the combination of Chang, Tang and Wong does not teach or suggest a server system that facilitates a messaging session between client systems and applies separate, digital watermarks to each message transferred in the messaging session to identify the client system from which each message originates.

Claims 3, 9, 12, 13, 20, 23, 24, 31, 34, and 35

As to claims 3, 9, 12, 13, 20, 23, 24, 31, 34, and 35, Applicants respectfully assert that because the independent claims 1, 14, and 25 upon which dependent claims 3, 9, 12, 13, 20, 23, 24, 31, 34, and 35 rely are not obvious in view of Chang in view of Tang and Wong, then the dependent claims 3, 9, 12, 13, 20, 23, 24, 31, 34, and 35 are also not obvious in view of Chang in view of Tang and Wong and the dependent claims should be allowed.

Claims 5, 16, and 27

First, Applicants respectfully assert that because the independent claims 1, 14, and 25 upon which these dependent claims 5, 16, and 27 rely are not obvious in view of Chang in view of Tang and Wong, then the dependent claims 5, 16, and 27 are also not obvious in view of

Chang in view of Tang and Wong and the dependent claims should be allowed. Second, the rejection is respectfully traversed.

Claim 5, which is representative of claims 16 and 27 in grounds of rejection, reads:

5. The method for recording a chat messaging session according to claim 1, said step of applying at said at least one server system, a separate distinguishable digital watermark further comprising the step of:

applying at said at least one server system, a separate textual watermark to each of said plurality of message entries within said chat messaging session.

The Examiner states that Chang et al, col. 4, lines 21-31 reads on the elements of claims 5, 16, and 27. [Office Action, p. 4]. Chang, col. 4, lines 21-31 describe:

In addition, the web browser 216 is equipped with encryption procedures 220, timestamp procedures 228, digital signature procedures 230, and random key generation procedures 232. The random key generation procedures 232 are used to generate session keys that are used in conjunction with the encryption procedures 220 to encrypt a return message. The digital signature 230 and timestamp 228 procedures enable the web browser to digitally sign and timestamp a return message 143. In addition, the initialization procedures 226 enable the web browser 216 to generate encryption keys 218 that are used to represent and verify a user's digital signature.

Previously, in the appeal brief dated March 14, 2006, Applicants asserted that Chang's digital signature does not teach or suggest a digital watermark and furthermore, that Chang's digital signature does not teach or suggest a textual digital watermark. The current rejection does not point out how Chang teaches a digital signature that is a textual watermark. Applicants continue to assert that Chang's digital signature does not teach a textual digital watermark, and therefore *prima facie* obviousness is not established for claims 5, 16, and 27, for the following reasons.

During patent examination, however, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). It is the use of the words in the context of the written description and customarily by those skilled in the relevant

art that accurately reflects both the “ordinary” and “customary” meaning of the terms of the claims; the ordinary and customary meaning of terms may be evidenced in dictionaries and treatises. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003); *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2s 1812. Applicants respectfully assert that when claims 5, 16, and 27 are given their broadest reasonable interpretation consistent with the specification and in view of the dictionary meanings of “digital watermark” and “digital signature” which establishes an “ordinary” and “customary” meaning for each of these terms, it is clear that Chang’s digital signature does not teach or suggest the textual digital watermark of claims 5, 16, and 27.

In particular, Applicants respectfully assert that in examining claims 5, 16, and 27 with the broadest reasonable interpretation consistent with the specification and consistent with the interpretation that those skilled in the art would reach, it is clear that a “digital signature”, which encrypts data for secure transmission, does not teach or suggest a “digital watermark”, which is data embedded in a file to identify origin and ownership. The terms “digital signature” and “digital watermark” have plain meanings that clearly show that applying a digital signature does not teach or suggest applying a digital watermark. Digital signature is defined as “a security mechanism used on the Internet that relies on two keys, one public and one private, that are used to encrypt messages before transmission and to decrypt them on receipt.” Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 159. Digital watermark is defined as “a unique identifier embedded in a file to deter piracy and prove file ownership and quality. Digital watermarking is often used with graphics and audio to identify the owner’s rights to these works.” Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 160. Moreover, the specification of the present invention and indicates a definition of watermarking in line with the dictionary definition, where the specification describes watermarking as “modifying the text, graphics, video, or audio included in a messaging session in a way such that the *origin of the messaging session is traceable and the integrity of the messaging session is later verifiable*” (Specification, p. 8, lines 19 -22) (emphasis added).

Therefore, because a digital signature and a digital watermark are different types of digital protection with different purposes; Chang et al.'s financial transaction system that enables web browsers to apply digital signatures (Chang et al., col. 4, lines 21-31) does not teach or suggest a server that applies textual digital watermarks to messaging session entries to identify the client system originating each entry.

Applicants note that in response to Applicants previous assertions that Chang does not disclose applying a digital watermark to a message because a digital signature encrypts data for secure transmission, the Examiner states "the examiner respectfully disagrees, as seen in col. 2, lines 20-29, there is a digital signature used to digitally "sign" a message. A digital signature does not equal encryption. A digital signature is a way to "sign" a message, which serves the same function as the claimed digital watermark." [Office Action, pp. 16-17] Applicants respectfully disagree with the Examiner's interpretation of Chang et al.'s teachings and respectfully assert that when Chang et al. col. 2, lines 20-29 is viewed as a whole, Chang et al. describes a digital signature with the same definition as asserted above. In particular, col. 2, lines 20-29 of Chang et al. read:

The web browser is provided with the capability to receive encrypted forms and to transmit messages containing timestamped, digitally signed, and encrypted form data. The web browser has the ability to provide each user with a pair of encryption keys, preferably a private and public key pair. The web browser's initialization procedure generates these keys during installation. The keys are stored in an encrypted format and are only accessible from within the browser. The private key is used to digitally "sign" a transaction message when so requested.

In addition, Chang, col. 4, lines 29-32 describe that "the initialization procedures 226 enable the web browser 216 to generate encryption keys 218 that are used to *represent* and verify a user's digital signature." (emphasis added). Thus, Chang et al., when viewed as a whole, does not generally teach "a digital signature used to digitally 'sign' a message" as stated by the Examiner, but instead teaches a private key, which is an encryption key, used to "sign" a transaction message. This definition of digital signature, used in Chang, matches with the definition of digital signature presented above as "a security mechanism used on the Internet that relies on two keys, one public and one private, that are used to encrypt messages before transmission and

to decrypt them on receipt.” Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 159. Chang’s digital signature does not teach a digital watermark applied to a message entry to identify the client system from which the message entry originated. Furthermore, even if the Examiner were correct that a digital signature is used to “sign” a transaction message, there is no portion of Chang that teaches or suggests that a digital signature is a textual signature.

Therefore, because Chang does not teach applying a textual digital watermark to a message entry and there is no teaching in Tang or Wong or in the combination of Chang, Tang or Wong that teaches or suggests applying a textual digital watermark to a message entry, Chang, Tang and Wong, separately or in combination, do not teach or suggest applying, at said at least one server system, a separate textual watermark to each of said plurality of message entries within said chat messaging session. Because Chang, Tang, and Wong do not teach or suggest at least one element of claims 5, 16, and 27, *prima facie* obviousness is not established for these claims and the claims should be allowed.

Claims 8, 19, and 30

First, Applicants respectfully assert that because the independent claims 1, 14, and 25 upon which these dependent claims 8, 19, and 30 rely are not obvious in view of Chang in view of Tang and Wong, then the dependent claims 8, 19, and 30 are also not obvious in view of Chang in view of Tang and Wong and the dependent claims should be allowed. Second, the rejection is respectfully traversed.

Claim 8, which is similar in subject matter and rejection to claims 19 and 30, reads:

8. The method for recording a chat messaging session according to claim 1, said method further comprising the step of:

transmitting said log of said chat messaging session to a plurality of users participating in said chat messaging session.

The Examiner rejects claims 8, 19, and 30 based on Chang, col. 4, lines 21-31, col. 5, lines 55-67 and col. 8, lines 59-66. [Office Action, p. 5] In particular, the Examiner states that

these portions of Chang disclose “processing requests and transactions from the user which includes their digital signatures.” [Office Action, p. 5]

The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a *prima facie* case of obviousness as to 8, 19, and 30 because there is no suggestion or motivation to modify Chang by Tang and Wong to teach transmitting said log of said chat messaging session to a plurality of users participating in said chat messaging session.

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Chang by Tang and Wong must come from the teachings the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Applicants respectfully assert that regardless of whether Chang describes “processing requests and transactions from the user which include their digital signatures”, there is no motivation or suggestion for modifying Chang by Tang and Wong to teach transmitting said log of said chat messaging session to a plurality of users participating in said chat messaging session.

Col. 4, lines 21-31, col. 5, lines 55-67, and col. 8, lines 59-66 of Chang, as cited by the Examiner, describe how a client web browser secures transaction message requests sent from the client to the server by attaching a digital signature to each transaction message request. Chang, as previously noted, ensures that the transaction between the financial server and a client system is secured from access by any other client system. *Chang*, col. 1, lines 59-61, col. 2, lines 10-13. Chang stores a secured log of the requests and transactions from a user. *Chang*, col. 5, lines 47-54. There is no motivation or suggestion in Chang for modifying Chang’s financial transaction system, which secures each transaction between the client system and the financial server, to

instead enable transmission of a secured transaction log between one client and the financial server to other clients of the financial server. Further, Applicants respectfully assert that Chang's secure communication mechanism, which is "used to ensure that financial transactions are securely transmitted between the user and server across a public network" (Chang, col. 1, lines 59-61) teaches away from any suggestion or motivation to modify Chang's financial server to enable any users to access the log of a financial transaction between the financial server and another user. Because Chang teaches away from modification of the secured financial system to enable any access to the log of a secured transaction by any other users, even if there were suggestion or motivation for modifying Chang by Wong to teach a server for facilitating instant messaging, there is still no motivation or suggestion for modifying Chang's financial transaction system to distributed secured transaction logs between a first user and the financial server to other users.

Therefore, because there is no motivation or suggestion for modifying Chang by Tang and Wong to teach transmitting said log of said chat messaging session to a plurality of users participating in said chat messaging session, a *prima facie* case of obviousness is not established for claims 8, 19, and 30 and the claims should be allowed.

Claims 36, 41, and 46

Claim 36, which is representative of system claim 41 and program product claim 46 with regard to similarly recited rejection, reads as follows:

36. A method, in a particular client system from among a plurality of clients systems enabled to communicate with one another through a chat messaging session channel facilitated by a chat messaging server via a network, for participating in a chat messaging session facilitated through said chat messaging session channel, said method comprising the steps of:

participating in a chat messaging session at said particular client system by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems; and

receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said

chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark.

The Examiner states the following grounds of rejection of claims 36, 41, and 45:

Regarding claims 36, 41, and 46, Chang teaches the method, system, and program for participating in a messaging session, said method, system, and program further comprising the step of:

receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark (col. 5, lines 55-67).

Chang fails to teach the limitation further including the use of a digital watermark on messages in a chat messaging system and a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract, col. 1, line 59-col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the messages originated from.

Chang and Tang fail to teach the limitation further including a messaging sever communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51). It would have been obvious to one of ordinary skill in the art at the same time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because

the signatures can convey where and whom the message originated from. [Office Action, pp. 7-8]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a prima facie case of obviousness as to 36, 41, and 45 for the following reasons.

There is no suggestion or motivation to modify Chang by Tang and Wong

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Chang by Tang and Wong must come from the teachings of the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

use of digital watermark on messages in a chat messaging system

The Examiner states that Chang discloses the elements of claims 36, 41, and 45 except “the limitation further including the use of a digital watermark on messages in a chat messaging system.” [Office Action, p. 9] The Examiner cites Tang as describing “the use of an audio signature attached to a data item in an instant messaging system (abstract, col. 1, line 59 – col. 2, line 49). [Office Action, p. 9] The Examiner concludes “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the messages originated from. [Office Action, p. 9]

Applicants respectfully assert that there is no suggestion or motivation for the modification of Chang by Tang to teach receiving, at said particular client system separate from participating in said chat messaging session, a recording of said chat messaging session from said chat messaging server, wherein said plurality of message entries for said chat messaging session are each embedded by a separate digital watermark, wherein each said separate digital watermark identifies a separate origin of each of said plurality of message entries from among separate ones of said plurality of client systems, such that use of said recording of said chat messaging session is traceable according to a watermark. In particular, Applicants respectfully assert that regardless of whether Tang actually teaches “use of a digital watermark on messages in a chat messaging session,” there is no motivation or suggestion for modifying Chang’s financial transaction system to teach communication via a chat messaging session or to teach use of a digital watermark on messages in a chat messaging system. In addition, Applicants respectfully note that the Examiner’s assertion that one would be motivated to modify Chang in view of Tang et al to use a digital watermark on messaging in a messaging system “because the signatures can convey where and whom the message originated from” does not address the primary issue of the lack of motivation or suggestion for modifying Chang to teach or suggest “a chat messaging session”.

Chang describes a financial server with “a repository of web pages associated with various financial services provided by a financial server. The web pages contain HTML documents and forms representing financial transactions that are exchanged between the user and the server.” *Chang*, col. 2, lines 1-5. In addition, Chang describes that encrypted HTML documents and encrypted HTML forms are downloaded to the user’s web browser from a financial server over a network and transferred from the user’s web browser to the financial server. *Chang*, col. 3, lines 66-20. Thus, Chang is a system that enables automated downloading of HTML pages and forms for user viewing and interaction within a web browser. In contrast, a chat messaging session enables a communication channel for real time conversation via computer between the two or more users at client systems. There is no motivation or suggestion, in Chang, Tang, or in the knowledge of one with skill in the art for modifying Chang’s automated communication session between a web browser and the financial server for enabling

secure transfer of HTML documents and forms, to instead teach an instantaneous communication session between the user and the financial server. As there is no suggestion or motivation for such a modification, Applicants respectfully assert that a *prima facie* case of obviousness is not established and claims 36, 41, and 45 should be allowed.

participating in a chat messaging session at said particular client system by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems

The Examiner states that Chang and Tang fail to teach the limitation of a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. [Office Action, p. 9] The Examiner cites Wong as describing “systems and methods for selecting criteria for a successful acknowledgement message criteria in instant messaging (see abstract). Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).” [Office Action, p. 10] The Examiner concludes that “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51).” [Office Action, p. 10]

Applicants respectfully assert that there is no motivation or suggestion to modify Chang by Tang and Wong to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Furthermore, Applicants respectfully note that claims 36, 41, and 45 teach a particular client system, from among a plurality of client systems enabled to communicate through a chat messaging session facilitated by a messaging

server. Applicants respectfully assert that there is no motivation or suggestion to modify Chang by Tang and Wong to teach a particular client system participating in a chat messaging session by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems.

Applicants respectfully assert that the Examiner's proposed modification of Chang by Tang and Wong to teach a messaging server for enabling a real time chat messaging session channel via the network between multiple client systems and a particular client system for participating in a chat messaging session would first require a motivation or suggestion for modifying Chang's financial server to enable communication between the client systems communicatively connected to the financial server and then would require a motivation or suggestion for modifying Chang's modified system to teach Wong's messaging system. There is no suggestion or motivation for both of these modifications.

First, Applicants respectfully assert there is no motivation for suggestion for modifying Chang et al's financial server system to facilitate communications between the client systems communicatively connected to the financial server system. Chang describes a financial transaction system with a communication mechanism that ensures that financial transactions are securely transmitted between the user at a client system and the server across a public network. *Chang*, col. 1, lines 56-61. The financial server system does not facilitate communications between client systems, and in fact, teaches away from such a modification by specifically teaching a financial system that secures the transactions between each client system and the server system so that no other system is able to read transacted data. *Chang*, col. 1, lines 56 through col. 2, line 9. Thus, regardless of whether there is motivation for modifying Chang to enable faster communication between a client system and the server system, there is not any suggestion or motivation for modifying the financial transaction system of Chang, which specifically secures communications between a client system and the financial system, to instead facilitate communication between multiple client systems. Therefore, there is also no suggestion or motivation for modifying Chang to teach a financial server that facilitates real-time communication between multiple client systems in a chat messaging session or a client system

that participates, via the financial server, in real-time communication with other client systems, and in fact, Chang teaches away from such a modification.

Second, Applicants respectfully assert that even if there were suggestion or motivation for modifying Chang by Tang, there is still not motivation or suggestion for modifying Chang by Tang and Wong. Even if there was motivation or suggestion for modifying Chang's secured transaction session between a financial server and a web browser at a client system to implement a chat messaging session between the financial server and a user at the web browser, as the Examiner asserts in the modification of Chang by Tang, there is still no suggestion or motivation for modifying the financial server of Chang to teach facilitating a chat messaging session between multiple client systems communicatively connected to the financial server. In particular, as previously stated, there is no motivation or suggestion for modifying Chang's financial server system, specifically designed to secure a transaction between a client system and the financial server from access by any other system, to instead teach a system for facilitating chat communications, even if secured, between the client systems communicatively connected to the financial server via the network.

Therefore, because there is no motivation or suggestion for modifying Chang or Chang in view of Tang to teach a server system for facilitating any kind of communication channel between multiple client systems, there is no suggestion or motivation for modifying Chang or Chang in view of Tang by Wong to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Furthermore, in view of the foregoing, there is no suggestion or motivation for modifying Chang in view of Tang and Wong to teach a particular client system participating in a chat messaging session by receiving from said chat messaging server a plurality of messaging entries as each messaging entry is entered by separate ones of a plurality of separate users participating in said chat messaging session through separate ones of said plurality of client systems. Because there is no suggestion or motivation for modifying Chang and Tang by Wong to teach each and every

element of claims 1, 14, and 25, a prima facie case of obviousness is not established and the claims should be allowed.

Chang, Tang, and Wong, separately or in combination, do not teach or suggest all of the claim limitations of claims 36, 41, and 45

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, each of the elements of claims 36, 41, and 45.

Applicants respectfully assert that when claims 36, 41, and 45 are viewed as a whole, the claims clearly teach a particular client system that (1) participates in a chat messaging session facilitated by a chat messaging server and (2) receives a recording of the chat messaging session from the chat messaging server, separate from the chat messaging session. Applicants respectfully assert that the combination of Chang, Tang and Wong does not teach a client system that both participates in a chat messaging session, receiving the message entries as they are entered, and separately receives a recording of the chat messaging session.

First, Applicants respectfully assert that Chang does not teach receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark, as asserted by the Examiner. Col. 5, lines 55-67 of Chang describe that the server may store an audit trail of each transaction received from a particular user, where a stored transaction may include the digital signature or timestamp on the transaction when received from a client system. Chang does not teach any system receiving a recording of a messaging session. At most, Chang describes the financial server storing a sequence of transaction records from a

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user as each transaction occurs. Applicants have amended claims 36, 41, and 45 to clarify that it is the client system receiving the recording of the messaging session. Chang does not teach a server system passing a recording of a messaging session to a client system or a client system receiving a recording of a message session between the financial server and the user.

Second, Applicants respectfully assert that even if Chang were modified to teach a messaging server for enabling chat messaging sessions between client systems, there is still no teaching or suggestion in Chang, Tang or Wong, separately or in combination, for a client system to both receive message entries as they are entered in the messaging session and separately received a recording of the message entries in the messaging session with watermarking of each message entry to indicate the origin of each entry. Chang does not teach a client system participating in a chat messaging session by receiving message entries from other client systems as each message entry is entered. In addition, Chang does not teach the client system separately receiving a recording of the messaging session with watermarked entries. Tang only describes a client system receiving an instant messaging communication with a watermark. Thus, the combination of Chang and Tang does not teach a client system receiving a recording of a chat messaging session with the message entries of the chat messaging session each embedded with a separate digital watermark identifying the origin of each entry. Further, even if Chang and Tang were modified by Wong's instant messaging system, the combination of references still does not teach a client system that participates in a chat messaging session, receiving entries as entered at other client systems, and separately receives a recording of the chat messaging session.

In conclusion, because Chang, Tang and Wong, separately and in combination, do not teach at least one element of claims 36, 41, and 45, a *prima facie* case of obviousness is not established and the claims should be allowed.

Claims 37-39, 42-44, and 47-49

As to claims 37-39, 42-44, and 47-49, Applicants respectfully assert that because the independent claims 36, 41, and 46 upon which dependent claims 37-39, 42-44, and 47-49 rely are not obvious in view of Chang in view of Tang and Wong, then the dependent claims 37-39,

42-44, and 47-49 are also not obvious in view of Chang in view of Tang and Wong and the dependent claims should be allowed.

Claims 54, 55, and 56

The Office Action rejects 54, 55, and 56 under 35 U.S.C. §103(a) as being allegedly unpatentable over Chang (US Patent 6,105,012) in view of Tang (US Patent 6,532,477). [Office Action, pp. 9, 10] The rejection is respectfully traversed.

Independent method claim 54, which is representative of system claim 55 and program product claim 56 with regard to similarly recited rejection, reads as follows:

54. A method, in a particular client system from among a plurality of clients systems enabled to communicate with one another through a chat messaging session channel facilitated by a chat messaging server via a network, for protecting message transmissions, said method comprising the step of:

detecting a new message entry entered at a client messaging system, wherein said new message entry is intended for transmission through said chat messaging session channel to said plurality of client system participating in a chat messaging session; and

applying a digital watermark to said new message entry prior to transmission for distribution within said chat messaging session, wherein said digital watermark identifies an origin of said new message entry from said particular client system, such that an origin of said new message entry is traceable to said client messaging system.

In the rejection of claims 54 and 56, the Examiner states the following grounds:

detecting a new message entry entered at said client messaging system;
and

applying a watermark to said new image entry prior to transmission for distribution within said messaging session, such that an origin of said new message entry is traceable to said client messaging system (fig. 1, fig. 2, col. 1, lines 55-65, col. 4, lines 21-31, col. 5, lines 55-67).

Chang fails to teach the limitation further including the use of a digital watermark on messages in a chat messaging system and a messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract, col. 1, line 59-col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the messages originated from.

Chang and Tang fail to teach the limitation further including a messaging sever communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51). It would have been obvious to one of ordinary skill in the art at the same time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the message originated from. [Office Action, pp. 11-12]

Similarly, the Examiner cites the same grounds of rejection for claim 55 as are stated for claims 54 and 56. [Office Action, pp. 13-14] Applicants note that claims 54 and 56 are amended to clarify that a client system participating in a messaging session applies and sends, which is already clearly taught in claim 55. Applicants traverse the rejection of claims 54, 55, and 56.

The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a *prima facie* case of obviousness as to 54, 55, and 56 for the following reasons.

There is no suggestion or motivation to modify Chang by Tang and Wong

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Chang by Tang and Wong must come from the teachings the references, and the examiner must explicitly point to the teaching within the

reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

use of digital watermark on messages in a chat messaging system

The Examiner states that Chang discloses the elements of claims 54, 55, and 56 except “the limitation further including the use of a digital watermark on messages in a chat messaging system.” [Office Action, p. 11] The Examiner cites Tang as describing “the use of an audio signature attached to a data item in an instant messaging system (abstract, col. 1, line 59 – col. 2, line 49).” [Office Action, p. 12] The Examiner concludes “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the messages originated from. [Office Action, p. 12]

Applicants respectfully assert that there is no suggestion or motivation for the modification of Chang by Tang to teach applying a digital watermark to said new message entry prior to transmission for distribution within said chat messaging session, wherein said digital watermark identifies an origin of said new message entry from said particular client system, such that an origin of said new message entry is traceable to said client messaging system. In particular, Applicants respectfully assert that regardless of whether Tang actually teaches “use of a digital watermark on messages in a chat messaging session,” there is no motivation or suggestion for modifying Chang’s financial transaction system to teach communication via a chat messaging session or to teach use of a digital watermark on messages in a chat messaging system. In addition, Applicants respectfully note that the Examiner’s assertion that one would be motivated to modify Chang in view of Tang et al to use a digital watermark on messaging in a messaging system “because the signatures can convey where and whom the message originated

from" does not address the primary issue of the lack of motivation or suggestion for modifying Chang to teach or suggest "a chat messaging session".

Chang describes a financial server with "a repository of web pages associated with various financial services provided by a financial server. The web pages contain HTML documents and forms representing financial transactions that are exchanged between the user and the server." *Chang*, col. 2, lines 1-5. In addition, Chang describes that encrypted HTML documents and encrypted HTML forms are downloaded to the user's web browser from a financial server over a network and transferred from the user's web browser to the financial server. *Chang*, col. 3, lines 66-20. Thus, Chang is a system that enables automated downloading of HTML pages and forms for user viewing and interaction within a web browser. In contrast, a chat messaging session enables a communication channel for real time conversation via computer between the two or more users at client systems. There is no motivation or suggestion, in Chang, Tang, or in the knowledge of one with skill in the art for modifying Chang's automated communication session between a web browser and the financial server for enabling secure transfer of HTML documents and forms, to instead enable instantaneous communication sessions between the user and the financial server. As there is no suggestion or motivation for such a modification, Applicants respectfully assert that a *prima facie* case of obviousness is not established and claims 54, 55, and 56 should be allowed.

applying a digital watermark to said new message entry prior to transmission for distribution within said chat messaging session

In addition, Applicants respectfully assert that there is no motivation to modify Chang by Tang and Wong because there is no motivation to modify Chang to teach a client system participating in a chat messaging session with other client systems via a financial transaction server or that client system applying a watermark to a new message entry to be transmitted in a messaging session to identify the origin of the message.

The Examiner states that Chang and Tang fail to teach the limitation of a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a

plurality of client systems communicatively connected to said network to facilitate said messaging session. [Office Action, pp. 11-12] The Examiner cites Wong as describing "systems and methods for selecting criteria for a successful acknowledgement message criteria in instant messaging (see abstract). Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19)." [Office Action, p. 12] The Examiner concludes that "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51)." [Office Action, p. 12]

Applicants respectfully assert that there is no motivation or suggestion to modify Chang by Tang and Wong to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Furthermore, Applicants respectfully note that claims 54, 55, and 56 teach a particular client system, from among a plurality of client systems enabled to communicate through a chat messaging session facilitated by a messaging server. Applicants respectfully assert that there is no motivation or suggestion to modify Chang by Tang and Wong to teach a particular client system applying a digital watermark to said new message entry prior to transmission for distribution within said chat messaging session, wherein said digital watermark identifies an origin of said new message entry from said particular client system, such that an origin of said new message entry is traceable to said client messaging system.

Applicants respectfully assert that the Examiner's proposed modification of Chang by Tang and Wong to teach a messaging server for enabling a real time chat messaging session channel via the network between multiple client systems and a particular client system for participating in a chat messaging session would first require a motivation or suggestion for modifying Chang's financial server to enable communication between the client systems

communicatively connected to the financial server and then would require a motivation or suggestion for modifying Chang's modified system to teach Wong's messaging system. There is no suggestion or motivation for both of these modifications.

First, Applicants respectfully assert there is no motivation for suggestion for modifying Chang et al's financial server system to facilitate communications between the client systems communicatively connected to the financial server system. Chang describes a financial transaction system with a communication mechanism that ensures that financial transactions are securely transmitted between the user at a client system and the server across a public network. *Chang*, col. 1, lines 56-61. The financial server system does not facilitate communications between client systems, and in fact, teaches away from such a modification by specifically teaching a financial system that secures the transactions between each client system and the server system so that no other system is able to read transacted data. *Chang*, col. 1, lines 56 through col. 2, line 9. Thus, regardless of whether there is motivation for modifying Chang to enable faster communication between a client system and the server system, there is not any suggestion or motivation for modifying the financial transaction system of Chang, which specifically secures communications between a client system and the financial system, to instead facilitate communication between multiple client systems. Therefore, there is also no suggestion or motivation for modifying Chang to teach a financial server that facilitates real-time communication between multiple client systems in a chat messaging session or a client system that participates, via the financial server, in real-time communication with other client systems, and in fact, Chang teaches away from such a modification.

Second, Applicants respectfully assert that even if there were suggestion or motivation for modifying Chang by Tang, there is still not motivation or suggestion for modifying Chang by Tang and Wong. Even if there was motivation or suggestion for modifying Chang's secured transaction session between a financial server and a web browser at a client system to implement a chat messaging session between the financial server and a user at the web browser, as the Examiner asserts in the modification of Chang by Tang, there is still no suggestion or motivation for modifying the financial server of Chang to teach facilitating a chat messaging session between multiple client systems communicatively connected to the financial server. In

particular, as previously stated, there is no motivation or suggestion for modifying Chang's financial server system, specifically designed to secure a transaction between a client system and the financial server from access by any other system, to instead teach a system for facilitating chat communications, even if secured, between the client systems communicatively connected to the financial server via the network.

Therefore, because there is no motivation or suggestion for modifying Chang or Chang in view of Tang to teach a server system for facilitating any kind of communication channel between multiple client systems, there is no suggestion or motivation for modifying Chang or Chang in view of Tang by Wong to teach a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. Furthermore, in view of the foregoing, there is no suggestion or motivation for modifying Chang in view of Tang and Wong to teach a particular client system applying a digital watermark to said new message entry prior to transmission for distribution within said chat messaging session, wherein said digital watermark identifies an origin of said new message entry from said particular client system, such that an origin of said new message entry is traceable to said client messaging system. Because there is no suggestion or motivation for modifying Chang and Tang by Wong to teach each and every element of claims 54, 55 and 56, a *prima facie* case of obviousness is not established and the claims should be allowed.

Lack of Obviousness under Chang, Tang, Wong, and Rodriguez separately or in combination in Claims 6, 7, 17, 18, 28, and 29

The Office Action rejects 6, 7, 17, 18, 28, and 29 under 35 U.S.C. §103(a) as being allegedly unpatentable over Chang (US Patent 6,105,012) in view of Tang (US Patent 6,532,477) and further in view of Rodriguez et al. (US Patent 6,650,761). [Office Action, pp. 11] The rejection is respectfully traversed.

Claims 6 and 7, which are representative of system claims 17 and 18 and program product claims 28 and 29, respectively, with regard to similarly received rejection, read:

6. The method for recording a chat messaging session according to claim 1, said step of applying a separate distinguishable digital watermark further comprising the step of:

applying a separate graphical watermark to each of said plurality of message entries within said chat messaging session.

7. The method for recording a chat messaging session according to claim 1, said step of applying a separate distinguishable digital watermark further comprising the step of:

applying a separate audible watermark to each of said plurality of message entries within said chat messaging session.

In the rejection of claims 6, 7, 17, 18, 28, and 29, the Examiner states the following grounds:

Chang teaches the invention substantially as claimed including a method and apparatus for securely transmitting transactions from an application program (see abstract). Tang teaches the invention substantially as claimed including a method and an apparatus for generating an audio signature for a data item based on a source identifier associated with the data item (see abstract). Wong teaches the invention substantially as claimed systems and methods for selecting criteria for a successful acknowledgment message criteria in instant messaging (see abstract).

As to claims 6, 7, 17, 18, 28, and 29, Chang, Tang, and Wong teach the method, system, and program of claims 1, 14, 25.

Chang, Tang and Wong fail to teach the limitation further including the use of a graphical and audible watermark.

However, Rodriguez teaches systems using such optical interfaces to control computers, and to navigate over or act as portals in networks (see abstract). Rodriguez teaches the use of an audio watermark (col. 44, lines 66-67) and a graphical watermark (col. 53, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Rodriguez to use a graphical and audible watermark. One would be motivated to do so because it would allow for different options of visible watermarking. [Office Action, pp. 11-12]

The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a *prima facie* case of obviousness as to claims 6, 7, 17, 18, 28, and 29 for the following reasons.

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Chang, Tang, and Wong by Rodriguez must come from the teachings of the references, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Applicants respectfully assert that there is no motivation to modify Chang, Tang, and Wong by Rodriguez because there is no motivation to modify a chat messaging server for digitally watermarking individual data message entries with an optical system for detecting a watermark stenographically encoded onto an object or paper product (Rodriguez, abstract, col. 1, lines 45-55). Claims 6, 7, 17, 18, 28, and 29, when each viewed as a whole, teach a chat messaging server for facilitating a chat messaging session between multiple client systems and digitally watermarking each message entry with either a graphical or audible digital watermark. Rodriguez describes an optical system that detects watermarks on objects or paper products. Rodriguez, abstract, col. 1, lines 45-55). In addition, the Examiner states that “Rodriguez teaches systems using such optical interfaces to control computers, and to navigate over or act as portals in networks (see abstract).” Applicants respectfully assert that merely because Rodriguez, col. 44, lines 66-67 describes a data field of an audio watermark and Rodriguez, col. 53, lines 51-58 describes the library of data, including icons, that can be selected to be embedded, there is no automatic motivation or suggestion to modify any system that teaches watermarking to also teach applying a graphical watermark or audible watermark. Further, there is no motivation or suggestion for modifying a chat messaging system that digitally watermarks message entries with an optical system, which though connected to a network, still scans watermarks from products. Therefore, because there is no motivation or suggestion to combine Rodriguez with Chang, Tang and Wong or to combine Rodriguez with the teachings of claims 1,

14, and 25, a prima facie case of obviousness is not established under 35 USC 103(a) in claims 6, 7, 17, 18, 28, and 29 and the claims should be allowed.

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,



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AMY J. PATTILO
Registration No. 46,983
P.O. BOX 161327
AUSTIN, TEXAS 78716
ATTORNEY FOR APPLICANTS
Telephone: 512-402-9820